

REMARKS

Applicant respectfully traverses the various rejections of pending claims 1-3, 5-12, and 14-18 because the cited combination does not correspond to the claimed invention and because the Examiner fails to provide a valid reason for the proposed modification of the Nishikido reference. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The instant Office Action dated November 16, 2007 listed the following rejections: claims 1-2, 5, 7, and 9 stand rejected under 35 U.S.C. § 103(a) over Nishikido *et al.* (JP 11177328) in view of Houlihan (U.S. Patent No. 5,467,324); claim 3 stands rejected under 35 U.S.C. § 103(a) over Nishikido and Houlihan and in further view of Hirai *et al.* (U.S. Patent No. 6,429,829); claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) over Nishikido and Houlihan in further view of McLean (GB 2036447); claims 10-11 stand rejected under 35 U.S.C. § 102(a) over Nishikido; claims 12 stands rejected under 35 U.S.C. § 103(a) over Nishikido in view of Hirai; claims 14 and 17-18 stand rejected under 35 U.S.C. § 103(a) over Nishikido in view of Houlihan; and claims 15-16 stand rejected under 35 U.S.C. § 103(a) over Nishikido and Houlihan in further view of McLean.

Applicant notes that minor amendments have been made to independent claims 1 and 10 to incorporate aspects of dependent claims 5 and 14 respectively. Applicant submits that the amended claims 1 and 10 have already been examined in the form of claims 5 and 14 respectively. Applicant notes that the claims have also been amended to improve readability by replacing physically-shortened with physically-short. Applicant submits that these amendments require only a cursory review by the Examiner. *See, e.g.*, M.P.E.P. § 714.13(I). Applicant further submits that these amendments place the claims in better form for any potential appeal. Accordingly, Applicant respectfully requests that these amendments be entered.

Applicant respectfully traverses the Section 103(a) rejections of claims 1-3, 5-9, and 14-18 (each of which is based upon Nishikido and Houlihan) because the cited portions of the Houlihan reference do not correspond to the claimed invention which includes, for example, aspects directed to a microphone located at an end of a physically-short electric antenna. The Examiner acknowledges that the Nishikido reference does not

disclose that there is a microphone located at the end of antenna 1. *See, e.g.* Figure 1. In an attempt to address this deficiency, the Examiner erroneously asserts that Houlihan teaches a microphone located at the end of a physically-short electric antenna. In actuality, the cited portions of Houlihan teach that a voice port 132 can be located on the end of tether member 136 (which can include a wire antenna), but Houlihan does not teach that tether member 136 is a physically-short electric antenna. *See, e.g.*, Figure 1 and Col. 3:21-40. Applicant notes that the Examiner has previously acknowledged that “Houlihan fails to disclose a physically-shortened electric antenna that is physically shorter than its electrical length.” *See* page 3 of the Office Action dated June, 1, 2007. Accordingly, the Section 103(a) rejections of claims 1-3, 5-9, and 14-18 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the Section 103(a) rejections of claims 1-3, 5-9, and 14-18 because the Examiner has provided no evidence of motivation to modify the Nishikido reference. This approach is contrary to the requirements of Section 103 and relevant law. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007)

“Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”

The Examiner erroneously asserts that one of skill in the art would modify Nishikido to include a microphone located at the end of antenna 1 in order to provide a wristwatch radiophone that can be used without the need to remove the apparatus from the user's wrist and without the need to plug any additional elements into the apparatus. However, the Houlihan reference attempts to achieve these benefits by placing one of voice ports 132 and 134 on the end of a retractable tether member 136, which can be pulled by the user from the wristwatch radio-telephone 100. *See, e.g.*, Figure 1 and Col. 3:21-40. For example, the user pulls out voice port 134 on tether 136 and places the voice port 134 near the user's ear while holding the user's wrist with the radio-telephone 100 adjacent the user's mouth, thus allowing the radio-telephone 100 to be used without removing it

from the user's wrist. Applicant submits that simply modifying Nishikido to include a microphone located at the end of antenna 1 would not achieve the benefits alleged by the Examiner as the reason why one of skill in the art would modify the Nishikido reference. Thus the Examiner fails to present a valid reason why one of skill in the art would modify Nishikido in the proposed manner.

Applicant further submits that, in the absence of a valid reason for the proposed modification of Nishikido, the Examiner appears to be improperly resorting to hindsight reconstruction based upon Applicant's disclosure in an attempt to arrive at a combination that corresponds to the claimed invention. *See, e.g.*, M.P.E.P. § 2142. The Examiner has simply identified elements and appears to be arranging these elements in the manner taught by Applicant's specification.

In view of the above, the Examiner has not provided any evidence as to why one of skill in the art would find the asserted combination obvious as required. Accordingly, the Section 103(a) rejections of claims 1-3, 5-9, and 14-18 are improper and Applicant requests that they be withdrawn.

Applicant respectfully submits that the Section 102(b) rejection of claims 10-11 and the Section 103(a) rejection of claim 12 are moot because the Nishikido reference does not teach or suggest that there is microphone located at the end of antenna 1. Thus, Applicant requests that these rejections be withdrawn.

09/616,635
B034367US

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Cordeiro, of NXP Corporation at (408) 474-9064 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

By: 

Name: Robert J. Crawford

Reg. No.: 32,122

651-686-6633

(NXPS.370PA)

CUSTOMER NO. 65913